

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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LARKIN, D

ART UNIT PAPER NUMBER

8

B2M1/1227

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DATE MAILED: 12/27/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 31 October 1995 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 42-48 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims 1, 7, 8, 10, 18-20, 22, 23, 29, and 35 have been cancelled.

3. Claims 42, 43, and 48 are allowed.

4. Claims 44-47 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on 31 October 1995. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

1. The corrected or substitute drawings have been received on 31 October 1995.

These drawings have been deemed acceptable by the Draftsman.

2. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

"focussing means positionally decoupled from the scanning mechanism" of claims 44 and 45; and

"positionally decoupled lens placed between the cantilever and the photodetector working in conjunction with the focussing means consisting of one or more lens of claims 46 and 47 must be shown or the feature cancelled from the claim. No new matter should be entered.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(l).

Correction of the following is required:

Providing "focussing means positionally decoupled from the scanning mechanism" of claims 44 and 45; and

Providing a "positionally decoupled lens placed between the cantilever and the photodetector working in conjunction with the focussing means consisting of one or more lens of claims 46 and 47.

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification as originally filed, does not provide support for the invention as now claimed.

The disclosure suggests that any lens or other objects can be used to create a focused point source (page 20, lines 16-22 and page 22, lines 23-26 through page 23, lines 1-10) or that other suitable lens positions can be determined (page 22, lines 23-26 through page 23, lines 1-10); however, the original disclosure in no way provides an explicit or implied suggestion that the focussing means are decoupled from the scanning means or using focussing means in combination with a lens mounted between the cantilever and the photodetector. This subject matter is deemed by the Examiner to constitute new matter.

5. Claims 44-47 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

✓ 6. The disclosure is objected to because of the following informalities:

✓ Page 1, lines 3 and 4: The phrase -- , now U.S. Patent No. 5,463,897 -- should be inserted after the date "August 17, 1993".

✓ Page 33, line 20: The phrase -- , now U.S. Patent No. 5,266,801 -- should be inserted after the phrase "U.S. Pat. Application 08/009,076". Appropriate correction is required.

7. Claims ^{42 43} 43, 44, and 48 are allowable over the prior art of record because the prior art fails to teach and/or make obvious the limitations of providing a steering lens mounted inside a scanning tube in combination with the remaining limitations of the claims.

8. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL** . See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

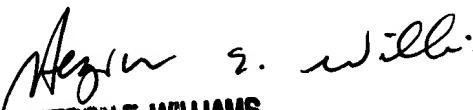
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Larkin whose telephone number is (703) 308-6724. The examiner can normally be reached on Monday-Friday from 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams, can be reached on (703) 305-4705. The FAX telephone number for this Group (Group 2200, unit 2212) is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.


Daniel Larkin


HEZRON E. WILLIAMS
SUPERVISORY PATENT EXAMINER
GROUP 2200

December 21, 1995